



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Am

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,431	11/13/2000	Marco M. Hurtado	SOM920000014US1	7725
23334	7590	03/25/2005	EXAMINER	
FLEIT, KAIN, GIBBONS, GUTMAN, BONGINI & BIANCO P.L. ONE BOCA COMMERCE CENTER 551 NORTHWEST 77TH STREET, SUITE 111 BOCA RATON, FL 33487			NOBAHAR, ABDULHAKIM	
			ART UNIT	PAPER NUMBER
			2132	

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/711,431

Applicant(s)

HURTADO ET AL.

Examiner

Abdulkhakim Nobahar

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24 November 2004 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4,5,12,13 is/are allowed.
- 6) ☒ Claim(s) 1-3,6-11 and 14-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. This communication is in response to applicants' amendment received on November 24, 2004.
2. Amendments to claims 1, 4-6, 8-10, 12, 14, 16, 17 and 18 are acknowledged and that do not introduce any new matter.
3. The terminal disclaimer filed on November 24, 2004 is not acceptable by the examiner, because it cites the wrong US Patent No. 6,098,056, but examiner acknowledges that the applicants' representative is faxing a new terminal disclaimer that refers to the correct US Patent No. 6,611,812 B2. ~~Thus, the double patenting rejection is withdrawn.~~
4. Applicants' arguments have been fully considered and are persuasive with regard to the rejection of claims under 35 U.S.C. § 102(e), because applicants have submitted a statement that the subject matter of Rusnak et al (6,098,056) and the pending application were commonly owned at the time the claimed invention was made. The Rusnak et al (6,098,056) reference is not disqualified under 35 U.S.C. § 102(a). See MPEP § 7.20.03 with respect to applications filed on or after November 29, 1999. Therefore, Examiner withdraws the claims' rejection under 35 U.S.C. § 102(e) and the new claims' rejection under 35 U.S.C. § 102(a) is as follows.

Bj

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-3, 10 and 11 are rejected under 35 U.S.C. 102(a) as being anticipated by Rusnak et al. (6,098,056; hereinafter Rusnak).

Rusnak discloses a system and method for limiting access to digital content in stored an information network including at least one client and a server. Rusnak further discloses that a trusted information handler (TIH) is also included in the information network which uses cryptographic techniques in controlling access to the stored digital information (see col. 2, lines 59-67).

Claims 1 and 10

Rusnak discloses that a meta-information associated with the stored encrypted digital content is distributed to one or more users and a client program displays it on the client device (see col. 4, line 55-col. 5, line 10). The digital content is encrypted with a Document Encryption Key (DEK) (corresponding to the recited first key). Rusnak further discloses that the meta-information includes information about the digital content that user is interested to purchase (col. 4, lines 20-30). The system of Rusnak deploys a

trusted information handler (TIH) for controlling access to the valuable digital information (col. 3, lines 8-17) and client(s) communicates with a Certificate Authority (CA) (corresponding to the recited authorization authority) in order to receive proper cryptographic keys for engaging in desired encryption and decryption operations (col. 5, lines 52-65). The connection among the client(s), the TIH and the server containing information in the Rusnak system are secured connections (col. 4, lines 2-10; col. 4, lines 31-36; col. 5, lines 27-32). Rusnak also discloses that the client or the user receives the decryption DEK from the server in order to decrypt the requested encrypted digital content (col. 5, lines 15-21).

Claim 2

Rusnak discloses that the client uses the DEK to decrypt the content to be processed for the intended purpose (corresponding to the recited playing at least part of the previously encrypted content) (col. 5, lines 23-27).

Claims 3 and 11

Rusnak discloses that a tamper-resistant environment is provided for the process of encryption/decryption of the cryptographic key and the digital content (col. 5, lines 40-47).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-9 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rusnak et al. (6,098,056; hereinafter Rusnak) in view of Shear et al. (US 2001/00442043 A1; hereinafter Shear).

Claims 6, 14 and 18

This claim is rejected as applied to the like elements of claims 1 and 10 as stated above and further the following:

Rusnak discloses that the client program sends to a server the document encryption key (DEK) and other necessary information such as its own public key and a certificate for authentication to receive permission for decrypting the requested digital content (col. 6, lines 8-35). Since a secure communication is established between the client and the server as stated above, thus the transmitted information between them containing the DEK is a secure container. Rusnak further discloses that after the authentication process is completed, the server sends a secure container to the client containing the re-encrypted decryption key (col. 6, lines 35-54).

Rusnak, however, does not expressly disclose the utilization of a clearinghouse for authentication purpose and obtaining permission to decrypt the requested digital content.

Shear discloses a cryptographic system for controlled usage of protected information stored on a media such as DVDs (see abstract, [0003] and [0031]). Shear further discloses that a third party such as a clearinghouse is used to authenticate and provide required permissions to client(s) for the usage of a digital content (see, for example [0064] and [0221]).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate a clearinghouse entity as taught in Shear in the system of Rusnak, because it would provide support services and at least one additional set of control for the usage of protected information by clients [0221].

Claims 7 and 15

Shear discloses that each type of information has its own associated key (see, for example, [0078] and [0129]-[0132]). I.e., multiple keys are used to decrypt different information to provide further security for the digital content.

Claims 8 and 16

Rusnak discloses that payment is received from a client before the content can be decrypted (col. 4, lines 1-10). This corresponds to receiving client's credit information in a secure connection by an authorization entity.

Claims 9 and 17

Shear discloses that metadata is stored with other information including unprotected information such as promotional data (see Fig. 3 and [0220]).

Allowable Subject Matter

1. Claims 4, 5, 12 and 13 are allowed.
2. The following is an examiner's statement of reasons for allowance:

The primary reasons for the allowance of the independent claims 4 and 12 are the inclusion of the following limitations that are not found in the prior art and they are uniquely distinct features. The closest prior arts are Rusnak et al (6,098,056) and Shear et al (2001/00442043 A1). Rusnak et al discloses a system for limiting access to and preventing unauthorized use of an owner's digital content stored in an information network and available to clients under authorized conditions. Shear et al teaches a system for rights management and protection techniques that fully satisfy the limited copy protection objectives while accommodating a wide range of more sophisticated rights management options and capabilities. However, These two arts, singularly or in combination, fail to anticipate or render the following limitations:

"Claims 4 and 12: reencrypting the decrypted content utilizing a unique local decrypting key;
storing the content in a library; and
decrypting at least part of the content from the library using the unique local decrypting key."

Art Unit: 2132


3. The dependent claims 5 and 13 are allowed because they were originally found to include a unique feature not found in the closest abovementioned art.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdulhakim Nobahar whose telephone number is 571-272-3808. The examiner can normally be reached on M-T 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free):

AN 
March 21, 2005

Abdulhakim Nobahar
Examiner
Art Unit 2132


GILBERTO BARRON JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100